

REMARKS

Note regarding claims

None of the claims (neither dependent nor independent) have been amended in this response. Therefore, the next office action has to be non-final if it is based on prior art not used by the Examiner in rejecting the claims in this office action. (See MPEP sec. 706.07(a))

Prior art rejections

Claims 1-8 and 19-22 have been rejected under 35 USC 103(a) as being unpatentable over Kane (6,112,014) in view of Casey (6,452,695) and further in view of Berkema (2003/0002072). It has been stated that claims 9-18 and 24-25 have been rejected under 35 USC 103(a) as being unpatentable over Yoshiura (5,854,693) in view of Casey, on page 9, paragraph 4 of the office action. However, it appears that this is incorrect, and that claims 9-18 and 24-25 should have been indicated as having been rejected under 35 USC 103(a) as being unpatentable over Yoshiura in view of Casey, and further in view of Berkema. This is because the Examiner, in discussing claims 9-18 and 24-25, states on pages 10-11 of the office action that Yoshiura and Casey fail to disclose certain limitations of these claims, but that Berkema discloses these limitations, such that it would be obvious to combine Casey and Yoshiura with Berkema to yield the inventions of these claims. Applicant respectfully requests clarification in this respect in the next office action, but treats claims 9-18 and 24-25 as having been rejected under 35 USC 103(a) over Yoshiura, Casey, and Berkema in combination, insofar as the Examiner specifically has relied upon Berkema in combination with Yoshiura and Casey in rejecting these claims.

Claims 1, 9, 19, and 24 are independent claims, from which the remaining pending claims ultimately depend. Applicant submits that independent claims 1, 9, 19, and 24 are patentable over Kane or Yoshiura in view of Casey and Berkema, such that the remaining claims are patentable at least because they depend from patentable independent base claims. Applicant again notes that all

the pending claims have been effectively rejected over a combination of references that include Berkema.

It is further noted that Berkema was published on January 2, 2003, whereas the claimed invention was filed on July 18, 2003. Therefore, Berkema is not a 102(b) reference, because it was not published more than one year before the filing of the present patent application. Rather, Berkema is a 102(e) reference, because it is a patent that was granted based on a patent application that was filed before the present patent application was filed. Note that Applicant is not saying that the claimed invention was rejected under 35 USC 102(e), but rather that Berkema is a 102(e) reference used in rejecting the claims under 35 USC 103(a).

Applicant submits that Berkema was commonly owned with the present patent application at the time the invention of the present patent application was made, such that Hamilton cannot be considered prior art pursuant to 35 USC 103(c). Pursuant to the requirements promulgated under MPEP sec. 706.02(l)(2)II.,¹ Applicant provides the following section.

¹ This section of the MPEP states that the “statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) Applicants may, but are not required to, submit further evidence . . . in addition to the above-mentioned statement concerning common ownership. For example, an attorney . . . [i]n her response for Application X states, in a clear and conspicuous manner that ‘Application X and Patent A were made at the time the invention of Application X was made, owned by Company Z.’ This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 USC 103(a) against the claims of Application X.”

**COMMON OWNERSHIP OF US PATENT APPLICATION 2003/0002072 AND
PRESENT PENDING US PATENT APPLICATION 10/623,166 AT THE TIME OF THE
INVENTION OF PATENT APPLICATION 10/623,166 WAS MADE**

Applicant hereby submits that US patent application 2003/0002072 and the present pending US patent application 10/623,166, at the time the invention of patent application 10/623,166 was made, were commonly owned by, and/or subject to an obligation of assignment to the same party, Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

Therefore, insofar as Berkema is not properly considered prior art, the claimed invention is patentable – and Applicant traverses the rejection of the pending claims under 35 USC 103(a) – for this reason.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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